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**MAY 04 2005**

**OFFICE OF PETITIONS**

In re Application of  
G. Scott Herron  
Application No. 09/905,704  
Filed: February 27, 2001  
Attorney Docket No. 464363000300

:  
: DECISION ON PETITIONS  
: UNDER 37 CFR 1.78(a)(3) AND  
: UNDER 37 CFR 1.78(a)(6)  
:

This is a decision on the renewed petition under 37 CFR 1.78(a)(3) and 1.78(a)(6) to accept an unintentionally delayed claim under 35 U.S.C. §§ 120, 365(c) and 119(e) for the benefit of prior-filed applications.

The petition is **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) and 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii) and 1.78(a)(5)(ii). In addition, the petition under 37 CFR 1.78(a)(3) and 1.78(a)(6) must be accompanied by:

- (1) the reference required by 35 U.S.C. §§ 120 and 119(e) and 37 CFR 1.78(a)(2)(i) and 1.78(a)(5)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional where there is a question whether the delay was unintentional.

The petition fails to comply with item (1) above.

37 CFR 1.78(a)(2)(i) and 1.78(a)(5)(i) require that any nonprovisional application claiming the benefit of one or more prior-filed copending nonprovisional applications or provisional applications must contain or be amended to contain a reference to each such prior-filed application, identifying them by application number (consisting of the series code and serial number) and indicating the relationship of the applications.

It appears that the amendment submitted on December 13, 2004, contains a reference to an application by its International Publication Number, WO 00/56988, filed March 24, 2000. As previously stated, 37 CFR 1.78(a)(2)(i) and 1.78(a)(5)(i) require that the amendment contain a reference to the prior-filed application, **identifying it by application number (consisting of the series code and serial number)**.

Additionally, applicant is attempting to claim benefit to provisional application No. 60/271,778, filed February 27, 2001, under 35 U.S.C. § 119(e). However, the USPTO records indicate that applicant converted provisional application No. 60/271,778 to nonprovisional application No. 09/905,704 pursuant to 37 CFR 1.53(c)(3). Therefore, applicant may not claim benefit to provisional application No. 60/271,778 under 35 U.S.C. § 119(e) because the provisional application no longer exists.

Accordingly, applicant failed to comply with the requirements of 37 CFR 1.78(a)(2)(iii) and 1.78(a)(5)(iii). Before the petition under 37 CFR 1.78(a)(3) and 1.78(a)(6) can be granted, a renewed petition under 37 CFR 1.78(a)(3) and 1.78(a)(6) and an amendment<sup>1</sup> or an Application Data Sheet, containing a reference to each prior-filed application(s) is required.

Applicant submitted a \$200.00 petition fee with the present renewed petition. The Office finance records indicate that the Office credited \$5.00 to applicant. Since applicant does not owe a fee for filing this renewed petition, the balance of \$195.00 will be credited to Deposit Account No. 19-2555.

Further correspondence with respect to this matter should be addressed as follows:

By mail:                      Mail Stop Petition  
                                    Commissioner for Patents  
                                    P.O. Box 1450  
                                    Alexandria, VA 22313-1450

By FAX:                      (703) 872-9306  
                                    Attn: Office of Petitions

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<sup>1</sup> Note 37 CFR 1.121 and 37 CFR 1.4(c).

By hand: Customer Service Window  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Any questions concerning this matter may be directed to Petitions Attorney Christina Tartera Donnell at (571) 272-3211.

A handwritten signature in cursive script, reading "Frances Hicks".

Frances Hicks  
Lead Paralegal  
Office of Petitions  
Office of the Deputy Commission  
for Patent Examination Policy